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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,266	10/29/2001	John D. Smith	PC-1059CIP	4315

23717 7590 03/28/2003

LAW OFFICES OF BRIAN S STEINBERGER
101 BREVARD AVENUE
COCOA, FL 32922

EXAMINER

NGUYEN, LONG B

ART UNIT PAPER NUMBER

3617

DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/008,266	SMITH	
	Examiner	Art Unit	
	Long B Nguyen	3617	

-- Th MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 is/are allowed.
- 6) ☒ Claim(s) 1-11 and 15-18 is/are rejected.
- 7) ☒ Claim(s) 12-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. Claims 1 and 9-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 5, 15-16 of U.S. Patent No. 6,309,027. Although the conflicting claims are not identical, they are not patentably distinct from each other because wheel cover of U.S. Patent 6,309,027 inherently has a blank surface portion for allowing indicia to be selectively added. The term "user" can be broadly interpreted to be the wheel cover manufacturer, the car manufacturer, the advertiser, or the vehicle owner.

2. Claims 2-3 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 5, and 15-16 of U.S. Patent No. 6,309,027 in view of Rogers. U.S. Patent '027 does not specify the indicia to include a stencil with at least two different forms of indicia and a marker. Roger teaches a stencil with at least two different forms of indicia and a marker. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize a stencil with at least two different forms of indicia and a marker because that would allow the indicia to be personalized.

3. Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 5, and 15-16 of U.S. Patent No. 6,309,027. Although the conflicting claims are not identical, they are not patentably

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distinct from each other because it would be obvious for a person with ordinary skill in the art to utilize a washable material such paint for allowing the indicia to be selectively removed. Paints can be washed using paint remover.

4. Claims 5-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 5, and 15-16 of U.S. Patent No. 6,309,027 in view of Corbusier. U.S. Patent '027 does not specify the indicia to be a decal with a peel and stick, a static cling backing portion, a backing portion having a removable fastener, or a magnetic backing. Corbusier teaches a peel and stick indicia. It would have been obvious for a person having ordinary skill in the art to utilize an indicia having a decal with a plurality of mechanical equivalent backings because the decal would allow the indicia to be safely changed without damaging the attached surface. Decals having a decal with a peel and stick, a static cling backing portion, a backing portion having a removable fastener, and a magnetic backing are well known in the decal art.

5. Claims 15-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 5, and 15-16 of U.S. Patent No. 6,309,027. Although the conflicting claims are not identical, they are not patentably distinct from each other because a person having ordinary skill in the art would interpret a vehicle to be an automobile, a truck, a bus, or a golf cart.

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Allowable Subject Matter

6. Claims 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claim 19 is allowed.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McAbee, Porraro, Hetz, McCormick, Shlemon, Morse, Jr., Vogelgesang, Rogers, Leander, Austin, and Sigel are cited to show indicia with different backings.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Long B Nguyen whose telephone number is 703.305.5201. The examiner can normally be reached on M-F with alternate Fridays off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel Morano can be reached on 703.308.0230. The fax phone numbers for the organization where this application or proceeding is assigned are 703.872.9326 for regular communications and 703.305.5201 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.1113.

lbn
March 21, 2003

Long Nguyen 3/21/03
LONG BAO NGUYEN
PATENT EXAMINER


S. JOSEPH MORANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600